

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Markus Matuschek et al.

Application No.: 10/541,750

Confirmation No.: 6025

Filed: September 6, 2005

Art Unit: 1656

For: Method For Producing Carotenoids Or Their
Precursors Using Genetically Modified
Organisms Of The Blakeslea Genus,
Carotenoids Or Their Precursors Produced By
Said Method And Use Thereof

Examiner: Chih Min Kam

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed November 29, 2007, Applicants hereby provisionally elect Group I, claims 1-56, ptef 1 promoter comprising SEQ ID NO: 35, and the vector pBinAHygBTpTEF1-HPcrtZ comprising SEQ ID NO: 37 for further prosecution with traverse. Applicants believe that there is no undue burden on the Examiner to search this invention.

Claims 1-8, 11, 13, 14-56 are readable upon the elected species.

As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to a method for producing carotenoids or their precursors using genetically modified organisms of the Blakeslea genus. See Specification at page 1, lines 6-8. The claimed method is applicable generally to produce any type of carotenoid or its precursors, independent to the promoter used. Similarly, the claim method is applicable to produce any type of carotenoid or its precursors, depending on the coding sequence chosen by one skilled artisan. Thus, Applicants respectfully request that the restriction be reconsidered and withdrawn entirely.

Additionally, it is respectfully submitted that a requirement for an election based on the species recited in a dependent claim is improper under PCT Rules which govern in a national stage application. The promoters and the vectors listed by the Examiner correspond to the species recited in the dependent claims. As explained above, the general inventive concept of the present application relates to a general method for producing carotenoids or their precursors. The Patent Office has not established the presence of Applicants' technical feature in the prior art. The inventions of all the claims thus share a common special technical feature in the prior art. A requirement for a further election based on the species recited in a dependent claim is therefore improper under PCT Rules. Therefore, Applicants respectfully request that the requirement for restriction to one promoter and one vector be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully reserve all rights to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141 upon the allowance of a generic claim.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application.

Accompanying this response is a petition for a two-month extension of time to and including February 29, 2008 to respond to the Office Action mailed November 29, 2007 with the required fee authorization. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13311-00009-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
Hui-Ju Wu, Ph.D.

Registration No.: 57,209
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
(302) 658-5614 (Fax)
Agent for Applicants

#579083